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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/584,661	09/19/2006	Pal Kocsis	0103-0004/2	5014
66024 7590 03/17/2010 RAKOCZY MOLINO MAZZOCHI SIWIK LLP 6 W. HUBBARD ST. SUITE 500 CHICAGO, IL 60610				
EXAMINER KIM, JENNIFER M				
ART UNIT		PAPER NUMBER		
1628				
MAIL DATE		DELIVERY MODE		
03/17/2010		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/584,661

**Applicant(s)**

KOCISIS ET AL.

**Examiner**

JENNIFER M. KIM

**Art Unit**

1628

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 December 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-7 and 16-23 is/are pending in the application.
- 4a) Of the above claim(s) 5,7,12,13,15,17,21 and 23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4,6,16,18-20 and 22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

The amendment filed December 10, 2010 have been received and entered into the application.

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 16, 18-20, 22 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the "treatment " of disease such as chronic pain, epilepsy or injuries of the motor system, does not reasonably provide enablement for the "**prevention** of a disease occurring in a mammal". The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to practice the invention commensurate in scope with these claims.

3. Enablement is considered in view of the Wands factors (MPEP 2164.01(a)). These include: nature of the invention, breadth of the claims, guidance of the specification, the existence of working examples, predictability of the prior art, state of

the prior art and the amount of experimentation necessary. All of the **Wands factors** have been considered with regard to the instant claims, with the most relevant factors discussed below.

**Nature of the Invention:** All of the rejected claims are drawn to a method for the prevention of a disease occurring in a mammal, said disease involving chronic pain, epilepsy or deriving from disorders and/or injuries of the motor system, characterized in that a therapeutically effective amount of pharmaceutical composition comprising a sodium channel blocker and a selective serotonin uptake inhibitor is given to the subject in need of such treatment. The nature of the invention is extremely complex in that it encompasses the actual prevention of a disease occurring in a mammal involving chronic pain, motor system (i.e. cancer, multiple sclerosis) such that the subject treated with above compounds does not contract a disease occurring in a mammal.

**Breadth of the Claims:** The complex of nature of the claims greatly exacerbated by breadth of the claims. The claims encompass **prevention** of a disease occurring in a mammal involving chronic pain, epilepsy or injuries of the motor system that can encompass a complex cell proliferation disorder or neurodegenerative disease in humans which has potentially many different causes (i.e. many different mutations or combination of mutations). Each of which may or may not be addressed by the administration of the claimed compounds.

**Working Examples:** All of the working examples provided by the specification are directed toward the treatment rather than prevention of a disease occurring in a mammal.

**State of the Art:** While the state of the art is relatively high with regard to treatment of a disease occurring in a mammal involving chronic pain (i.e. cancer), the state of the art with regard to prevention of such disease is underdeveloped. In particular, there do not appear to be any examples or teachings in the prior art wherein a compound similar to the claimed compounds was administered to a subject to prevent development of a disease occurring in a mammal.

**Predictability of the Art:** The lack of significant guidance from the specification or prior art with regard to the actual prevention of a disease occurring in a human subject with the claimed compounds makes practicing the claimed invention unpredictable in terms of prevention of a disease occurring in a mammal.

**The amount of Experimentation Necessary:** In order to practice claimed invention, one of skilled in the art would have to first envision a combination of appropriate pharmaceutical carrier, compound dosage, duration of treatment, route of administration, etc. and appropriate animal model system for one of the claimed compounds and test the combination in the model system to determine whether or not the combination is effective for prevention of a disease occurring in a mammal. If unsuccessful, which is likely given the lack of significant guidance from the specification or prior art regard prevention of a disease

occurring in a mammal with any compound, one of skill in the art would have to then either envision a modification of the first combination of pharmaceutical compound, compound dosage, duration of treatment, route of administration, etc. and appropriate animal model system, or envision an entirely new combination of the above, and test the system again. If again unsuccessful, which is likely given the lack of significant guidance from the specification of prior art regarding prevention of a disease occurring in a mammal with any compound, the entire, unpredictable process would have to be repeated until successful. Therefore, it would require undue, unpredictable experimentation to practice the claimed invention to prevent the development of a disease occurring in a mammal by administration of one of the claimed compounds.

Therefore, a method for the prevention of a disease occurring in a mammal, said disease involving chronic pain, epilepsy or deriving from disorders and/or injuries of the motor system, characterized in that a therapeutically effective amount of pharmaceutical composition comprising a sodium channel blocker and a selective serotonin uptake inhibitor is given to the subject in need of such treatment is not considered to be enabled by the instant specification.

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-4, 6, 16, 18-20 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fitzgerald et al. (1998) in view of Coe et al. (U.S. 2001/0036943A1) and further in view of Carson et al. (U.S. Patent No. 6,191,142 B1).

Fitzgerald et al. teach that lamotrigine is a novel anticonvulsant but effective in the management of chronic pain refractory to more conventional treatment. Fitzgerald et al. teach that the current indication of lamotrigine includes the treatment of neuropathic pain. (title, see under Lamotrigine). Fitzgerald et al. teach that the Lamotrigine is well absorbed after oral use with bioavailability approaching 80%. Fitzgerald et al. teach that the dosage of lamotrigine for the treatment of chronic pain at 25mg per day and increase by 25mg weekly until a dosage of 200mg per day is reached. (under Lamotrigine, pharmacokinetics and dose guidelines).

Fitzgerald et al. lack sertraline.

Coe et al. teach that sertraline is useful for the treatment of acute, chronic and/or neuropathic pain (abstract, claims 1 and 14).

Carson et al. report that neuropathic pain is defined as **pain** caused by aberrant somatosensory processing in the peripheral or central nervous system that is **chronic** or debilitating. (column 1, lines 21-30).

To employ combinations of lamotrigine and sertraline to treat chronic pain condition such as neuropathic pain would have been obvious because all the

components are well known individually for treating chronic pain conditions such as neuropathic pain. It would be expected that the combination of components would treat chronic pain conditions such as neuropathic pain as well. The motivation for combining the components flows from their individually known common utility (see *In re Kerkhoven*, 205 USPQ 1069(CCPA 1980)).

One of ordinary skill in the art would have combined the analgesic agents by known methods and that in combination, each element merely would have performed the same analgesic activity as it did separately. The convenience of putting the compounds having the same analgesic activity of lamotrigine and sertraline together in one dosage form, though perhaps a matter of great convenience does not produce a "new" or "different" function and to those skilled in the art, the use of the old elements in combination would have been obvious. Thus, the claims fail to patentably distinguish over the state of the art as represented by the cited references.

None of the claims are allowed.

### **Response to Arguments**

Applicants' arguments filed December 10, 2010 have been fully considered but they are not persuasive. With regard to the restriction requirement, Applicants argue that the method share common substantial structural feature: the parallel administration of sodium channel blockers and selective serotonin uptake inhibitors. This is not

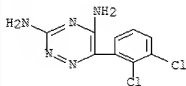


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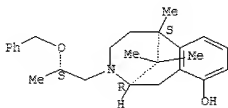
persuasive because each of the compounds to be utilized lacks the common chemical structural moiety having different chemical/physical properties:

For example:

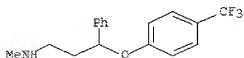
Lamotrigine (Na channel blocker):



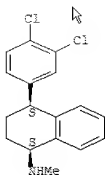
Crobenetine (Na channel blocker)::



Fluoxetine (selective serotonin uptake inhibitor (SSRI)):



Sertraline (selective serotonin uptake inhibitor (SSRI)):



Further, the medical disorders to be treated therein lack the same special technical features because they have different known etiologies and different known treatments. Therefore, the restriction under 35 U.C.121 and 372 made final in the previous Office Action is deemed proper.

With regard to 35 U.S.C. 103(a) rejection, Applicants argue that Fitzgerald et al.'s statements that there is little or no evidence supporting the use of a SSRI for the treatment of chronic pain, one of skill in the art would not have motivated by Fitzgerald et al. to use a SSRI in a method for treating chronic pain. This is not persuasive because Fitzgerald clearly teaches that lamotrigine is effective in the management of chronic pain refractory to more conventional treatment including the treatment of neuropathic pain while Coe et al. teach that sertraline is useful for the treatment of acute, chronic and/or neuropathic pain. The motivation for combining the components flows from their individually known common utility (see *In re Kerkhoven*, 205 USPQ 1069(CCPA 1980)). Further, Carson et al. was cited to show that the neuropathic pain is a chronic pain condition.

### **Allowable Subject Matter**

The data on page 11 table 3 of instant specification has been carefully reviewed and considered. Claims drawn to the "potentiating effect" of the elected species with the specific disorders set forth in claim 16 would be favorably considered if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 1st paragraph set forth in this Office action.

Applicants attention is drawn to a prior art, Barberich et al. (U.S. 2002/0151543A1) which teaches pharmaceutical compositions comprising fluoxetine and flumazenil (sodium channel blocker) for the treatment of seizures, motor neuron disorders and convulsive disorders.

### **Communication**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JENNIFER M. KIM whose telephone number is (571)272-0628. The examiner can normally be reached on Monday through Friday 6:30 am to 3 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brandon Fetterolf can be reached on 571-272-2919. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JENNIFER M KIM/  
Primary Examiner, Art Unit 1628

Jmk  
January 6, 2010